

REMARKS

In the Office Action identified above, the Examiner rejected claims 1, 4, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. (U.S. Patent No. 6,784,021) ("Abe") in view of He (U.S. Patent No. 6,620,651) ("He"); rejected claims 2, 3, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He, and further in view of Sasaki et al. (U.S. Patent No. 6,294,439) ("Sasaki"); rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He, and further in view of Nam et al. (U.S. Patent Application Publication No. 2002/0109217) ("Nam"); rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He and Nam, and further in view of Rogowski (U.S. Patent No. 5,684,707) ("Rogowski"); rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He, and further in view of either Wojewnik et al. (U.S. Patent No. 6,640,434) ("Wojewnik") or Varaprasad et al. (U.S. Patent No. 5,910,854) ("Varaprasad"); rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, and either Wojewnik or Varaprasad, and further in view of Rogowski; rejected claim 13 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, and Sasaki, and further in view of Rogowski; rejected claim 14 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, and further in view of Bura et al. (U.S. Patent No. 4,489,487) ("Bura"); rejected claims 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, and further in view of Cobbley et al. (U.S. Patent

Application Publication No. 2004/0154956A1) ("Cobbley"); and rejected claims [17-18]¹ under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, and further in view of Oki et al. (U.S. Patent No. 5,605,844) ("Oki").²

In the present Amendment, Applicant has amended claims 1, 6, 17, and 18 to correct typographical errors. Claims 1-4 and 6-18 remain pending. Applicant respectfully traverses the Examiner's rejections of claims 1-4 and 6-18 set forth in the Office Action. Applicant submits that claims 1-4 and 6-18 are allowable over the art of record.

Applicant respectfully traverses the Examiner's rejection of claims 1, 4, and 6-7 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He. A *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 4 (October 2005), p. 2100-134.

¹ Applicant notes that in paragraph 11 of the Office Action, the Examiner initially indicates that claims 15-16 are rejected, but then discusses the limitations of claims 17 and 18. Therefore, Applicant assumes that the Examiner intended to reject claims 17 and 18.

² The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

A *prima facie* case of obviousness has not been established because, among other things, Abe and He, taken alone or in combination, fail to teach or suggest each and every element recited in independent claim 1, for example. In particular, the applied references fail to teach or suggest, at least, the claimed “cutting an element adhesive film held by a *porous adsorption member* according to the shape of one of the semiconductor elements to form a sectioned element adhesive film” (emphasis added), as recited in claim 1.

Abe is entirely silent as to the claimed “porous adsorption member.” Indeed, the Office Action does not even address this claimed feature. Accordingly, claim 1 is distinguishable over Abe at least for this reason.

Moreover, since Abe fails to teach or suggest the claimed “porous adsorption member,” Abe certainly fails to teach the claimed step of “cutting an element adhesive film held by a *porous adsorption member* according to the shape of one of the semiconductor elements to form a section element adhesive,” as further recited in claim 1. Applicant notes that the Examiner acknowledges as much at page 2 of the Office Action, “Abe ‘021 fails to show cutting an element adhesive film to form a sectioned element adhesive film.” Nevertheless, the Examiner contends that He teaches “an adhesive film for adhering a semiconductor element to a base material can be cut from a sheet of adhesive film, picked up by a vacuum collet.” Office Action at page 3. Applicants respectfully disagree.

He discloses a decal that is provided on a wafer dicing tape. According to He, the adhesive decal is picked-up from the wafer dicing tape and placed onto the chosen

substrate. He, Col. 3, lines 33-34. He, however, does not teach that the dicing tape is a porous adsorptive material. Accordingly, He also fails to teach the claimed “porous adsorptive member,” and contrary to the Examiner’s assertion, necessarily fails to teach or suggest the claimed step of “cutting an element adhesive film held by a *porous adsorption member* according to the shape of one of the semiconductor elements to form a section element adhesive,” as recited in claim 1. Thus, He fails to overcome the deficiencies of Abe, and claim 1 is allowable over the Examiner’s proposed combination of Abe and He. In addition, claim 4 is allowable over the applied references at least due to its dependence from claim 1.

Claim 6, while of different scope, recite features similar to those recited in claim 1. Claim 6, therefore, is allowable over Abe and He at least for the reasons disclosed above in regard to claim 1, and claim 7 is allowable due to its dependence from claim 6.

Applicant respectfully traverses the rejection of claims 2, 3, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He, and further in view of Sasaki. Claims 2 and 3 depend from claim 1 and thus require each and every requirement recited in claim 1. A *prima facie* case of obviousness has not been established because, among other things, Abe, He, and Sasaki, taken alone or in combination, fail to teach or suggest each and every element recited in claim 1 and required by dependent claims 2 and 3. As discussed above, Abe and He fail to teach or suggest the claimed “cutting an element adhesive film held by a porous adsorption member according to the shape of one of the semiconductor elements to form a sectioned element adhesive film,” as recited in claim 1. Sasaki is also silent as to the

claimed “porous adsorption member,” and thus fails to teach or suggest the claimed “cutting an element adhesive film held by a porous adsorption member according to the shape of one of the semiconductor elements to form a sectioned element adhesive film.” Sasaki, therefore, does not cure the above-noted deficiencies of both Abe and He, and claims 2, 3, and 12 are allowable at least due to their corresponding dependence from claims 1 and 6.

Applicant respectfully traverses the Examiner’s rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Abe and He, and further in view of Nam; the rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He and Nam, and further in view of Rogowski; the rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He, and further in view of either Wojewnik or Varaprasad; the rejection of claim 11 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, and either Wojewnik or Varaprasad, and further in view of Rogowski; the rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, and Sasaki, and further in view of Rogowski; the rejection of claim 14 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, and further in view of Bura; the rejection of claims 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, and further in view of Cobbley; and the rejection of claims 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, and further in view of Oki. None of Nam, Rogowski, Wojewnik, Varaprasad Bura, Cobbley, and Oki teach or suggest the claimed “cutting an element adhesive film held by a porous adsorption member according to the shape of one of the

semiconductor elements to form a sectioned element adhesive film," and the Examiner does not rely on these references for such teachings either. Accordingly, Nam, Rogowski, Wojewnik, Varaprasad Bura, Cobbley, and Oki fail to overcome the shortcomings of Abe and He discussed above, and claims 8-11, 13-18 are allowable at least due to their dependence from claim 6.


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 11, 2006

By: 
Selah C. Park
Reg. No. 57,127